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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,366	02/11/2005	Jurgen Meyer	032301.411	9856
25461	7590	07/10/2006	EXAMINER	
SMITH, GAMBRELL & RUSSELL 1850 M STREET, N.W., SUITE 800 WASHINGTON, DC 20036			HAILEY, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/524,366		MEYER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Patricia L. Hailey		1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/11/05, 08/04/05</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

Applicants' Preliminary Amendment, filed on February 11, 2005, has been made of record and entered. No claims have been canceled; new claims 8-20 have been added.

Claims 1-20 are now pending in this application.

*Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on February 11, 2005.

*Claim Rejections - 35 USC § 101/35 U.S.C. § 112*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. *Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.*

Claim 6 recites the phrase "Use of the silanised,..." which renders the claim drawn to non-statutory subject matter.

5. *Claim 6 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example Ex parte Dunki, 153 USPQ 678 (Bd.App. 1967) and Clinical Products, Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).*

This claim has not been further treated on the merits.

In the event that claim 6 is re-written to overcome this rejection, this claim (and any claims depending therefrom) will be subject to an election by original presentation, as Applicants' have already had an action on the merits on the claims directed to the silanised, structurally modified, pyrogenically produced silicas.

6. *Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

Claim 6 provides for the use of silanised, structurally modified, pyrogenically produced silicas, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### *Double Patenting*

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. *Claims 1, 7, and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4-9 of copending Application No. 10/532,202.*

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are directed to silanised, structurally modified, pyrogenically produced silicas, whereas the claims in the copending application are directed to pulverulent materials and mixtures thereof, in that they contain one or more surface-modified and structure-modified pyrogenically

prepared metalloid or metallic oxides, later defined as a "silanized structure-modified silica having alkylsilyl groups attached to said silica" (claim 5 in the copending application).

Both sets of claims also recite the same physical chemical properties. See instant claim 8 and claim 9 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. *Claims 1-4 and 7-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Deller et al. (U. S. Patent No. 5,776,240, Applicants' submitted art).*

Deller et al. disclose granules based on silicon dioxide having properties comparable to that recited in Applicants' claim 8. The particles may be prepared by dispersing pyrogenically prepared silicon dioxide in water, spray drying it and silianizing the granules obtained with agents such as halosilanes, alkoxysilanes, silazanes, and/or siloxanes. See col. 1, line 48 to col. 2, line 5 of Deller et al.

Exemplary agents include organosilanes of the type  $(\text{RO})_3\text{Si}(\text{C}_n\text{H}_{2n+1})$ , where R is alkyl and  $n = 1$  to 20. Preferably, the silanizing agent is trimethoxyoctylsilane. See col. 3, lines 20-21 and col. 5, lines 32-33 of Deller et al.

The silanization may be carried out by spraying the granular material with the silanizing agent, and subsequently heat-treating (under a protective inert gas, such as nitrogen) the mixture at a temperature of from  $105^\circ\text{C}$  to  $400^\circ\text{C}$  over a period of 1 to 6 hours.

The silanization can be carried out with heatable mixers equipped with spraying facilities; examples include ploughshare mixers, disk dryers, or fluidized bed dryers. See col. 6, lines 6-11 of Deller et al.

In view of these teachings, Deller et al. anticipate claims 1-4 and 7-16.

**11. *Claims 1-4 and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ettlinger et al. (U. S. Patent No. 5,665,156).***

Ettlinger et al. teach silanized, pyrogenically prepared silicic acids that are prepared by treating said silicic acids with an organosilane selected from the group  $(\text{RO})_3\text{SiC}_n\text{H}_{2n+1}$ , in which  $n$  is from 10 to 18 and R is alkyl. See col. 1, lines 22-27 of Ettlinger et al.

Examples of the organosilane include hexadecyltrimethoxysilane and octadecyltrimethoxysilane. See col. 2, lines 14 and 15 of Ettlinger et al.

Patentees' silicic acids are prepared in that the pyrogenically prepared silicic acids are placed in a mixer, and while being mixed the silicic acids are sprayed, optionally first with water and then with the organosilane compound; mixing is continued for from 15 to 30 minutes, and then temperature stabilization is done at a temperature ranging from 100°C to 160°C over a period of time from 1 to 3 hours. See col. 2, lines 8-24 of Ettlinger et al.

The silanized silicic acids of Ettlinger et al. have properties comparable to those recited in claim 8, except for the DBP value; however, given that the reference teaches the remaining claimed properties, one skilled in the art would anticipate the silanized silicic acids of Ettlinger et al. to exhibit a comparable DBP value. See Table 2 of Ettlinger et al.

The silanized silicic acids disclosed in Ettlinger et al. are employable as thickening agents in liquids, such as water-dilutable paints, resins, rubber, cosmetic articles, toner powders, as agents for improving pourability, and as reinforcing fillers. See col. 3, lines 13-20 of Ettlinger et al.

In view of these teachings, Ettlinger et al. anticipate claims 1-4 and 7-11.

**12. Claims 1, 3, 7, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bock et al. (U. S. Patent No. 6,020,419).**

Bock et al. disclose transparent coating compositions used as starting materials such as clear lacquer applications (col. 2, lines 18-27), comprising a material consisting



of nanoscale primary particles incorporated as solids. See col. 2, lines 28-31 of Bock et al.

Examples of these materials include pyrogenic silicas; surface-modified ones are preferred, said modification is conventionally achieved with compounds such as octyltrimethoxysilane. See col. 3, lines 57-67 of Bock et al.

The Example of Bock et al. depicts application of a lacquer to an aluminum sheet.

In view of these teachings, Bock et al. anticipate claims 1, 3, 7, and 17-20.

### *Conclusion*

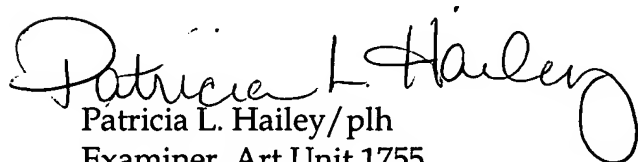
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Patricia L. Hailey/plh  
Examiner, Art Unit 1755  
June 26, 2006

  
ELIZABETH WOOD  
PRIMARY EXAMINER  
AU 1755